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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,423	07/08/1999	JOACHIM B. KOHN	P-22577-H-US	8089

7590 09/07/2005

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EXAMINER

PATEL, NIHIR B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,423

Applicant(s)

KOHN ET AL.

Examiner

Nihir Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06.10.2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 15-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06.02.03; 10.09.01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of **group I (claims 1-14)** in the reply filed on June 10th, 2005 is acknowledged. The traversal is on the ground(s) that the inventions be not only distinct but also independent.. This is not found persuasive because as stated in the previous office action the claimed medical device of claims 15-20, 24-26 are capable of dispensing medicaments other than those claimed recited in other groups. Also the polymer recited in claims 1-14 could possibly be used in other applications such as being applied to bandages..

The requirement is still deemed proper and is therefore made FINAL.

Claim **15-38** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 10th, 2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim **1** is rejected under 35 U.S.C. 102(b) as being anticipated by Kohn et al. (US 5,670,602).

Referring to claim **1**, Kohn discloses a synthesis of amino acid-derived bioerodible polymers that comprises that describes the structure illustrated in the claim wherein R9 is an

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alkyl, aryl or alkylaryl group with up to 18 carbon atoms having a pendent carboxylic acid group or the benzyl ester thereof (see column 5 lines 1-5 and column 5 lines 60-65).

Referring to claim 2, Kohn discloses an apparatus wherein R₉ has a structure selected from the group consisting of the structure described in the claim, wherein R₂ is hydrogen or a benzyl group and a and b are independently 0, 1 or 2 (see column 5 lines 60-67).

Referring to claim 3, Kohn discloses an apparatus wherein R₉ has the structure described in the claim, wherein a is 2 and b is 1 (see column 3 lines 40-45).

Referring to claim 4, Kohn discloses an apparatus wherein the pendent group of R₉ is a benzyl carboxylate group (see column 4 lines 5-15).

Referring to claim 5, Kohn discloses an apparatus that further comprises monomeric repeating units having the structure described in the claim wherein R₁₂ is an alkyl, aryl, alkylaryl group with up to 18 carbon atoms having a pendent carboxylic acid ester group selected from the group selected from the group consisting of straight and branched alkyl and alkylaryl esters containing up to 18 carbon atoms and ester derivatives of biologically and pharmaceutically active compounds covalently bonded to the polymer, provided that the ester group is not a benzyl group that is removed by hydrogenolysis (see column 4 lines 5-15).

Referring to claim 6, Kohn discloses an apparatus wherein R₁₂ has a structure selected from the group consisting of the structure described in the claim, wherein R₁ is selected from the group consisting of straight and branched alkyl and alkylaryl groups containing up to 18 carbon atoms and derivatives of biologically and pharmaceutically active compounds covalently bonded to the polymer; and c and d are independently 0, 1 or 2 (see column 5 lines 60-67).

Referring to claim 7, Kohn discloses an apparatus wherein R₁₂ has the structure described in the claim, wherein c is 2 and d is 1 (see **column 3 lines 40-45**).

Referring to claim 8, Kohn discloses an apparatus wherein the ester group of the pendent carboxylic acid ester group of R₁₂ is a straight-chained alkyl group selected from the group consisting of ethyl, butyl, hexyl and octyl groups (see **column 4 lines 5-15**).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 9 through 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohn (WO 97/19996).

Referring to claim 1, Kohn discloses a synthesis of amino acid-derived bioerodible polymers that comprises that describes the structure illustrated in the claim wherein R₉ is an alkyl, aryl or alkylaryl group with up to 18 carbon atoms having a pendent carboxylic acid group or the benzyl ester thereof (see **page 7 lines 5 and 6**).

Referring to claim 9, Kohn discloses an apparatus that comprises a block copolymerized with poly(alkylene oxide) repeating units, each poly(alkylene oxide) repeating unit comprising between about 5 and 3000 alkylene groups containing up to 4 carbon atoms (**see page 7 lines 10-15**).

Referring to claim 10, Kohn discloses an apparatus wherein the alkylene group of each alkylene oxide is ethylene (**see page 9 lines 15-16**).

Referring to claim 11, Kohn discloses an apparatus that comprises each poly(alkylene oxide) repeating unit contains between about 20 and about 200 alkylene oxide groups (**see page 9 lines 15-18**).

Referring to claim 12, Kohn discloses an apparatus that comprises block copolymerized with poly(alkylene oxide) repeating units, each poly(alkylene oxide) repeating unit comprising between about 5 and about 3,000 alkylene oxide groups containing up to 4 carbon atoms (**see page 9 lines 15-18**).

Referring to claim 13, Kohn discloses an apparatus wherein the alkylene of each alkylene oxide is ethylene (**see page 9 lines 10-20**).

Referring to claim 14, Kohn discloses an apparatus that comprises each poly(alkylene oxide) repeating unit contains between about 20 and about 200 alkylene oxide groups (**see page 9 lines 15-18**).

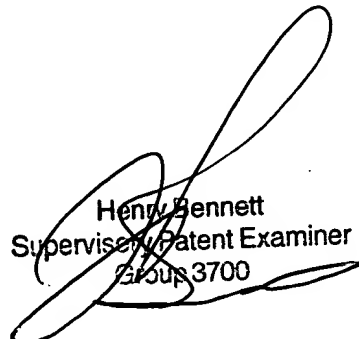
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communication from the examiner should be directed to Nihir Patel whose telephone number is (571) 272-4803. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful the examiner supervisor Henry Bennett can be reached at (571) 272 4791.

NP
August 12th, 2005



Henry Bennett
Supervisor Patent Examiner
Group 3700